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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/633,001

08/01/2003

Walter Harvey Waddell

2003B079

8961

23455 7590 04/17/2007  
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EXAMINER

RONESI, VICKEY M

ART UNIT

PAPER NUMBER

1714

SHORTENED STATUTORY PERIOD OF RESPONSE	MAIL DATE	DELIVERY MODE
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3 MONTHS

04/17/2007

PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

**Office Action Summary**

Application No.

10/633,001

Applicant(s)

WADDELL ET AL.

Examiner

Vickey Ronesi

Art Unit

1714

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 24 January 2007.  
2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.  
3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-25,27-35,38-43 and 46-83 is/are pending in the application.  
4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.  
5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.  
6) ☒ Claim(s) 1-25,27-35,38-43 and 46-83 is/are rejected.  
7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.  
8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.  
10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).  
11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) ☐ All b) ☐ Some \* c) ☐ None of:  
1. ☐ Certified copies of the priority documents have been received.  
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☐ Notice of References Cited (PTO-892)  
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)  
3) ☐ Information Disclosure Statement(s) (PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_.  
4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_.  
5) ☐ Notice of Informal Patent Application  
6) ☐ Other: \_\_\_\_\_

## **DETAILED ACTION**

### ***Continued Examination Under 37 CFR 1.114***

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 1/24/2007 has been entered.

### ***Claim Rejections - 35 USC § 103***

2. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior office action.

3. Claims 1-25, 27-35, 38-43, and 46-83 are rejected under 35 U.S.C. 103(a) as being unpatentable over Dias et al (WO 02/48257 A2, cited on IDS dated 12/15/03).

The rejection is adequately set forth in paragraph 5 of Office action mailed 3/29/2006 and is incorporated here by reference.

### ***Response to Arguments***

4. Applicant's arguments filed 1/24/2007 have been fully considered but they are not persuasive. Specifically, applicant argues (A) that applicant is not required to present proper side-by-side examples and (B) that applicant's data is reasonably commensurate in scope with the scope of the claims.

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With respect to argument (A), the examiner has studied applicant's statistical "model" and logic, however, it is not made clear why this precludes the necessity of a proper side-by-side examples. Applicant states that it is only with a combination of 80-200 phr carbon black with  $N_2SA < 30 \text{ m}^2/\text{g}$  and  $DBP < 80 \text{ cm}^3/100 \text{ g}$  and a polybutene oil that a desirable combination of permeability properties and strength, flexibility, processability, etc is provided. Applicant provides an inventive composition (Example 21) with 60 phr inventive carbon black and polybutene oil and compares this to a composition (Example 8) with 60 phr black with  $N_2SA = 34 \text{ m}^2/\text{g}$  and  $DBP = 90 \text{ cm}^3/100 \text{ g}$  and naphthentic oil. This data is deficient for two reasons. First, the inventive data contains carbon black in a total amount of 80 phr or greater, wherein the comparative only contain carbon black in an amount of 60 phr. Therefore, it is not possible to establish a criticality for the presently claimed carbon black when it could be the greater amount of carbon black which provides for improved air impermeability properties. Note that Tables 5 and 6 show that increased carbon black results in improved lower impermeability. Second, the fact that the comparative data does not include polybutene oil is another concern because Dias already teaches polybutene oil as the required processing oil. Applicant has not made a comparison to the closest prior art. Case law holds that comparative showings must compare the claimed subject matter with the closest prior art to be effective. See *In re Burckel*, 592 F.2d 1175, 1179, 201 USPQ 67, 71 (CCPA 1979). In particular, Dias et al already teaches the desirable use of polybutene oil. Without a showing that non-inventive carbon blacks would be different when combined with polybutene oil in amounts greater than 80 phr, no criticality can be established for the presently claimed invention.

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With respect to argument (B), the examiner has considered the 3 types of carbon black used in the inventive data in the specification as originally filed and maintains that these carbon blacks are not commensurate in scope with the claimed carbon black which has DBP < 80 cm<sup>3</sup>/100 g. In particular, Regal 90 (DBP = 33 cm<sup>3</sup>/100 g), Regal 90 (DBP = 32 cm<sup>3</sup>/100 g), and N-990 (DBP = 42 cm<sup>3</sup>/100g) are exemplified, wherein DBP of 32, 33, and 42 cm<sup>3</sup>/100 g cannot be used to establish criticality for less than 80 cm<sup>3</sup>/100 g when compared to N660 (DBP 90 cm<sup>3</sup>/100 g). Additionally, the exemplified amounts of carbon black are only as high as 120 phr. Given that the amount of carbon black significantly affects the properties as shown by Tables 5 and 6, applicant cannot establish a statistically commensurate scope of up to 200 phr carbon black (note that this amount of carbon black is not the total amount of all carbon black, rather, it is the amount of carbon black having surface area < 30 m<sup>2</sup>/g and DBP < 80 cm<sup>3</sup>/100g).

Furthermore, only two types of polybutene oil (Parapol<sup>TM</sup> 1300 and 2400) are exemplified which have Mn (1300 and 2350, respectively) and viscosity at 100°C (630 cSt and 3200 cSt, respectively) which are not reasonably commensurate in scope with the claimed polybutene oil of Mn > 700 and viscosity at 100°C of 10-6000 cSt.

Finally, only bromobutyl elastomers are exemplified and cannot establish criticality for presently claimed generic elastomer comprising at least 30 mol % isobutylene.

Case law holds that evidence of superior properties in one species is insufficient to establish the nonobviousness of a subgenus containing hundreds of compounds). *In re Greenfield*, 571 F.2d 1185, 1189, 197 USPQ 227, 230 (CCPA 1978).

*Conclusion*

5. All claims are drawn to the same invention claimed in the application prior to the entry of the submission under 37 CFR 1.114 and could have been finally rejected on the grounds and art of record in the next Office action if they had been entered in the application prior to entry under 37 CFR 1.114. Accordingly, **THIS ACTION IS MADE FINAL** even though it is a first action after the filing of a request for continued examination and the submission under 37 CFR 1.114. See MPEP § 706.07(b). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the mailing date of this final action.

6. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Vickey Ronesi whose telephone number is (571) 272-2701. The examiner can normally be reached on Monday - Friday, 8:30 a.m. - 5:00 p.m.

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Vasu Jagannathan can be reached on (571) 272-1119. The fax phone number for the organization where this application or proceeding is assigned is (571) 273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

4/11/2007  
Vickey Ronesi

*WR*

*Vasu Jagannathan*  
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